



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : BALLOUTINE, Anthony Confirmation No.: 2257
Serial No. : 10/766,196 Examiner: SUHOL, Dmitry
Filed : January 29, 2004 Group Art Unit: 3725
For : METHOD AND APPARATUS FOR PROVIDING A CARD WITH
PENMANSHIP IMPROVING INDICIA

Request for Pre-Appeal Brief Conference

Commissioner for Patents
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Sir:

For the reasons set forth below, Applicant requests that the final rejection of claims 1-6 and 8-11 be reviewed and that the rejection of these claims be overturned.

Summary of Arguments

Claims 1-5 and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over Sherman in view of Hockaday or Pitts. As part of the bases for the rejection, it is alleged that, under the holding of *In re Gulack*, the claims are unpatentable because there is no “functional relationship” between the claimed substrate and the printed indicia.

Applicant respectfully submits that the asserted rejection of claims 1-5 and 10 is clearly erroneous because, 1) a *prima facie* case of obvious has not been established because no explanation has been provided as to why it would have been obvious to one

of skill in the art to combine the references in the manner proposed, and 2) the holding in *In re Gulack* does not support the assertion of unpatentability in this case because a clear functional relationship does, in fact, exist between the printed indicia and the substrate and, contrary to the assertion in the grounds of rejection, this relationship is more than one of "mere support."

Claims 6, 8 and 11 are rejected under 35 U.S.C. § 102 as being anticipated by Prince and claim 9 is rejected under 35 U.S.C. § 103 as being unpatentable over Prince. The rejections of claims 6, 8, 9 and 11 are clearly erroneous at least because a *prima facie* case of neither anticipation (claims 6, 8 and 11) nor obviousness (claim 9) has been established because the grounds of rejection fail to address each and every element of the claims.

Arguments

Claims 1-5 and 10

With respect to claims 1-5, the grounds of rejection assert that *Sherman* discloses the claimed invention *except for the content and arrangement of indicia* but that the content and arrangement of the indicia is obvious. (Final Office Action, March 1, 2006, page 3). That is, claim 1 recites, *inter alia*, "a marking area comprising penmanship improving indicia comprising ink capable of disappearing." The grounds of rejection further assert that it would have been obvious to one of skill in the art to provide the disappearing ink of *Sherman* in the claimed manner, i.e., as penmanship improving indicia comprising disappearing ink, "since it would only depend on the intended use of the assembly and the desired information to be displayed and since

Pitts and *Hockaday* both clearly teach that it is known to provide a substrate and indicia... ." This is an insufficient basis under 35 U.S.C. § 103 to render the claimed invention obvious because it embraces classic hindsight reconstruction and nowhere is it explained why a skilled artisan would find it obvious to place penmanship improving indicia made out of disappearing ink onto the writing surface. That is, a *prima facie* case of obviousness has not been established because it has not been established why a skilled artisan would be motivated to combine the references in the manner proposed.

Indeed, disappearing ink may be disclosed in *Sherman*, and guide marks for a writing surface may be disclosed in *Pitts* and *Hockaday*. However, as explained in detail in Applicant's response dated October 19, 2005, e.g., at pp. 8-10, both *Pitts* and *Hockaday* disclose alternative guide structures that have nothing to do with, and nowhere contemplate, the use of disappearing ink. Nowhere in the record, other than in Applicant's specification, is the idea of using disappearing ink to make the penmanship improving indicia even remotely considered an, thus, no *prima facie* case of obviousness has been established for any of claims 1-5 and the 103 rejection of these claims should be overturned.

Claim 10 recites a method including "treating the writing surface with a disappearing substance to form the penmanship improving indicia." Thus, for similar reasons to those discussed above, no *prima facie* case of obviousness has been established with respect to the rejection of claim 10 and the 103 rejection of this claim should be overturned.

Additionally, as explained in Applicant's April 21, 2005 response, e.g., at page 8, reliance on *In re Gulack* as a basis for rejecting the instant claims is misplaced. In particular, the grounds of rejection assert that "it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art." (Final Office Action, March 1, 2006, page 4). As detailed in the April 21, 2005 response, however, in this case, just like in *In re Gulack*, there is a clear relationship between the substrate and the claimed printed matter. That is, the penmanship improving indicia is functionally related to the writing surface in that it provides guide marks so a writer can write more legibly, etc., when writing on the writing surface. Accordingly, *In re Gulack* fails to support an obviousness rejection in the present case and for this additional reason, the §103 rejection of claims 1-5 and 10 should be overturned.

Claims 6, 8, 9 and 11

Independent claim 6 recites, *inter alia*, that a reaction process is initiated "when said activating cover is placed over said writing surface, thereby causing said substance to disappear." The grounds of rejection fail to point to any portion of *Prince* that discloses this requirement. In fact, nowhere in *Prince* is a cover disclosed that causes penmanship improving indicia to disappear "when the cover is placed over" the writing surface. Because each of claims 8, 9 and 11 depend from claim 6, for at least this reason a *prima facie* case of anticipation has not been established and the §102 rejection of claims 6, 8, and 11 and the §103 rejection of claim 9 should be overturned.

Conclusion

In view of the foregoing, as well as the remarks presented in at least the April 21, 2005 and October 19, 2005 responses, Applicant submits that the rejections asserted against claims 1-6 and 8-11 are erroneous and that all of the claims of the present application are allowable. Accordingly, reconsideration of the rejections and favorable disposition of the present application are respectfully requested.

Respectfully submitted,
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